

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
Reply to Office Action of April 9, 2007
Date: July 9, 2007

Remarks

Amendments to the Specification

Applicants have amended paragraphs 0019 and 0020 of the specification to have the stereomicroscope consistently referred to by reference no. 20. Applicants respectfully request entry of this amendment to the specification into the record.

The § 112, second paragraph Rejections of Claims 1, 9, and 13

The Examiner rejected Claims 1, 9, and 13 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention. Specifically, the Examiner stated that Claims 1, 9, and 13 contained a narrow limitation within a broad limitation, namely the broad recitation “cutting apparatus” within the narrower recitation of “a microtome or an ultramicrotome”. Applicants thank the Examiner for noting this error.

Applicants have amended Claims 1, 9, and 13 by deleting the “cutting apparatus” limitation and claiming the narrower “microtome or ultramicrotome” limitation. Applicants respectfully request reconsideration and withdrawal of the rejections of Claims 1, 9, and 13 under § 112, second paragraph.

Additionally, Applicants have also amended Claims 2-6, which depend directly or indirectly from Claim 1, to also claim the narrower “microtome or ultramicrotome” limitation.

The § 103 Rejections of Claims 1-6, 8-11, and 13

The Examiner rejected Claim 1 under 35 U.S.C. § 103 (a) as obvious over U.S. Patent No. 3,103,844 to Persson (“Persson ‘844” or “the ‘844 patent” in view of U.S. Patent No. 5,748,366 to Yasunaga, et al. (“Yasunaga” or “the Yasunaga patent”). Applicants have amended Claim 1 to include the limitation that the curved rigid guide I mounted on the body of the microscope or observation device. This is seen in Figures 3 and 4 and described in Applicants respectfully traverse this rejection and request reconsideration.

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
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To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants respectfully submit that the combined Persson '844 patent and Yasunaga references fail to render Claim obvious as they fail together to teach all the limitations of Claim 1, they do not suggest to a person of ordinary skill in the art any modification of those two references that would render the invention of Claim 1 obvious, and they do not provide motivation to a person of ordinary skill in the art to modify those to disclosures to render Claim 1 obvious.

First, the '844 patent and the Yasunaga patent together fail to teach or suggest all the limitations of Claim 1. Specifically, Claim 1 claims a microtome or ultramicrotome in which the curved rigid guide (reference no. 33) encloses the pivoting device. In Figure 3 of the instant application, pivoting device 28 is seen within or enclosed by rigid guide 33. This is also explained in paragraph 0020 stating, "As a result, segment 34 [part of pivoting device 28] is displaced within its curved, rigid guide 33." (Emphasis added.) (See amended paragraph 0020 in previous Reply dated January 10, 2007.) In contrast to the Examiner's statement, the Yasunaga patent shows the direct opposite arrangement, namely the curved rigid guide 7 within or inside of the pivoting device 11. (See Figures 3 and 4 of Yasunaga.) Thus, Yasunaga patent discloses the exact opposite relationship between the pivoting device and the curve rigid guide that is claimed in Claim 1.

Second, taken together, the '844 patent and the Yasunaga patent fail to suggest or teach to a person of ordinary skill in the art to reverse the arrangement of the pivoting device and the curved rigid guide so as to have the curved rigid guide enclose the pivoting device. Applicants respectfully point out that the '844 patent fails to teach or suggest any type of guide for the

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
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pivoting device and thus cannot teach or suggest any specific relationship between the pivoting device and a guide. The Yasunaga patent only teaches the opposite structural relationship between the pivoting device and the guide and provides no motivation or suggestion to reverse the pivoting device- curved guide relationship disclosed in the Yasunaga patent.

In addition, Applicants respectfully traverse the Examiner's statement that Yasunaga provides any motivation to combine the pivot assembly of that patent with the '844 patent to render Claim 1 obvious. The Examiner states that the motivation to combine is that the pivot assembly of Yasunaga makes it easy to observe the part being operated from every angle. (See Yasunaga col. 2, lines 53-54.) However, this statement refers to the description of the actual invention in the Yasunaga patent which is described in the immediately prior lines as being "disposed at a position distant from the microscope body, thus does not disturb the operator who handles the microscope body and performs the operation..." (See Yasunaga, col. 2, lines 50-52.) (Emphasis added.) Applicants respectfully point out that in the instant invention the pivoting device and the positioning device of Claim 1 are actually mounted directly on the microscope body, not at a position distant from the microscope body. Therefore, Applicants respectfully submit that the Yasunaga patent actually fails to provide any motivation either to place the pivoting device and positioning device on the microscope body or to place the curved rigid guide outside the pivoting device to render Claim 1 obvious when combined with the '844 patent.

Therefore, Applicants submit that because the combined '844 patent and Yasunaga patent fail to both teach or suggest all the elements of Claim 1 and provide any motivation to modify the disclosures of those patents to place the pivoting device within the curved guide of the pivoting device on the microscope body, they fail to render Claim 1 obvious. Applicants respectfully request reconsideration and allowance of Claim 1.

The Examiner rejected Claims 1-5, 8-10, and 13 under 35 U.S.C. § 103 (a) as obvious over the '844 patent to Persson in view of the Yasunaga patent and further in view of U.S. Patent No. 4,277,133 to Staehle ("Staehle" or "the Staehle patent"). Applicants respectfully traverse these rejections and request reconsideration.

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
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As noted above, the combined Persson '844 and Yasunaga patents fail to render Claim 1 obvious as they both separately and together fail to teach or suggest the correct structural relationship between the pivoting device and the positioning device and also fail to provide any motivation to be combined with each other to render Claim 1 obvious. The Examiner cited the Staehle patent as specifically teaching the use of detents positions on a pivoting device. Applicants respectfully point out that as Claim 1 does not include a detent limitation, the Staehle patent does not act to render Claim 1 obvious when combined with the '844 patent and Yasunaga. Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 1 as obvious over Persson '844 in view of Yasunaga and further in view of Staehle.

Claim 2 depends from Claim 1 and thus incorporates the limitation in which the pivoting device is enclosed within the curved rigid guide. In addition, Claim 2 specifically claims the limitation of the detent element arranged on the curved rigid guide that encloses the pivoting device. As noted above, Persson '844 and Yasunaga both fail to teach or suggest a pivoting device enclosed within a curved rigid guide. Similarly, the Staehle patent fails to teach or suggest a guide that encloses the pivoting device within the guide and is mounted on the microscope body. Staehle, like Persson '844 and Yasunaga, also fails to supply any motivation to modify its disclosed instrument to enclose the pivoting device within the guide or on the body. Thus, the combined Persson '844, Yasunaga, and Staehle patents fail to render Claim 2 obvious.

"If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Claims 3-5 depend from Claim 2 and thus incorporate all the limitations of that claim. Because, as discussed above, the Persson '844, Yasunaga, and Staehle patents fail to render obvious Claim 2, they also fail to render obvious Claims 3-5. Applicants respectfully request the removal of the rejections of Claims 3-5 and allowance of those claims.

Claim 8 is an independent apparatus claim. Similar to Claim 2, Claim 8 includes as limitations a pivoting device, a positioning device and a detent element for positioning the pivoting device in which the detent element is arranged on a curved rigid guide that encloses the pivoting device. As noted above, no one of the cited Persson '844, Yasunaga, or Staehle patents

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
Reply to Office Action of April 9, 2007
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disclose a curved rigid guide that encloses a pivoting device and none of those references, taken either separately or together, make any suggestion to modify the guide and pivoting device arrangements they do disclose to enclose the pivoting device within a curved rigid guide or place it on the microscope body. Applicants respectfully request reconsideration and allowance of Claim 8.

Claim 9 is an independent method claim. Applicants have amended Claim 9 to include the limitation that the positioning device is enclosed within a curved rigid guide and on the body of the observation device. Support for this amendment is found in Figure 3 and paragraph 0020 of the instant application. None of the cited references show a pivoting device mounted within a curved rigid guide. Persson '844 lacks a guide of any sort and thus cannot teach or suggest a guide. Staehle is cited to show the use of detents and shows no guide mounted on a microscope body. Finally as discussed above, the Yasunaga patent shows the opposite relationship between a guide and a pivoting device and specifically teaches the placing of the pivoting device away from the observant body. Therefore, not only do the combined Persson '844, Yasunaga, and Staehle patents fail to teach or suggest all the elements of Claim 9, they offer no motivation to be combined to render Claim 9 obvious.

Claim 10 depends from Claim 9 and thus incorporates all the limitations of that claim. Because, as discussed above, the Persson '844, Yasunaga, and Staehle patents fail to render obvious Claim 9, they also fail to render obvious Claim 10. Applicants respectfully request the removal of the rejections of Claims 10 and allowance of that claim.

The Examiner rejected independent apparatus Claim 13 as obvious over Persson '844 in view of the Yasunaga patent and further in view of the Staehle patent. Applicants respectfully traverse the rejection and request reconsideration.

Claim 13 includes the limitation of a pivoting device enclosed within a curved rigid guide. As noted in the discussions above regarding Claim 9 and 10, none of the cited references disclose, teach or suggest a curved rigid guide enclosing a pivoting device mounted on the body of an observation device. Persson '844 lacks a curved rigid guide altogether, Yasunaga teaches only the opposite structural relationship of a pivoting device enclosing a guide and only the

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
Reply to Office Action of April 9, 2007
Date: July 9, 2007

positioning of a pivoting device away from the microscope body, and Staehle only discloses detents. Thus, it can be seen that the combine references fail to teach all the limitations of claim, 13 and provide motivation not to be combined to render Claim 13 obvious.

The Examiner rejected Claims 1 and 6 under 35 U.S.C. § 103 (a) as obvious over Persson '844 in view of Yasunaga and further in view of U.S. Patent No. 3,405,578 to Persson ("Persson '578" or "the '578 patent"). Applicants respectfully traverse this rejection and request reconsideration.

As noted previously, the Persson '844 and Yasunaga patents fail to render Claim 1 obvious as they together only teach a pivoting device outside a curve rigid guide. Although the Examiner cites the '578 patent for its teaching of utilizing a scale to indicate the position of a microscope, Claim 1 does not include the limitation of using a scale to determine pivoting device position. Applicants respectfully submit that the '578 patent, like Persson '844 and Yasunaga, fails to teach any sort of guide that would suggest enclosing a pivoting device. Therefore, because the combined Persson '844, Yasunaga, and Persson '578 patents fail to teach or suggest all the limitations of Claim 1 they fail to render Claim 1 obvious.

Claim 6 depends from Claim 1 and thus incorporates all the limitations of that claim. Because, as discussed above, the combined Persson '844, Yasunaga, and Persson '578 patents fail to render obvious Claim 1, they also fail to render obvious Claim 6. Applicants respectfully request the removal of the rejections of Claim 6 and allowance of that claim.

The Examiner rejected Claims 9 and 11 under 35 U.S.C. § 103 (a) as obvious over Persson '844 in view of Yasunaga in further view of Staehle as applied to Claims 1-5, 8-10, and 13 and further in view of Persson '578. Applicants have amended independent Claim 9 to claim the method in which the pivoting device is enclosed within a curved rigid guide and mounted on the body of the observation device. Because the Persson '844, Yasunaga, and Staehle references are applied as in Claims 1-5, 8-10, and 13, the arguments discussed above apply here. To summarize, those references fail to render Claim 9 obvious as they fail to disclose a pivoting

Attorney Docket No. LVIP:112US
U.S. Patent Application No. 10/709,871
Reply to Office Action of April 9, 2007
Date: July 9, 2007

device enclosed by a rigid guide and mounted on an observation device body. Persson '844 fails to teach any guide, as does Staehle. Yasunaga specifically teaches both the opposite structural relationship between a guide and a pivoting device and mounting the pivoting device off the body of the observation device. Staehle is only cited to indicate the use of a scale in relation to the cutting edge of a microtome blade. The Examiner states that the motivation to combine arises from the use of a scale to examine the cutting edge of a knife. However, there is no motivation provided by Staehle to place the pivoting device on the microscope nor is there any suggestion in Staehle of a curved guide at all, let alone a guide enclosing the pivoting device. Thus, Applicants respectfully submit that, in regarding the teachings of the cited references as a whole, the combined references fail to teach or suggest a method for presetting a microtome that includes a pivoting device enclosed a pivoting device within a curved rigid guide and mounted on a microscope. Only the Yasunaga patent teaches guides at all and it teaches only the exact opposite relationship with the guide within, not enclosing, the guide. Moreover, Yasunaga provide no motivation to combine with any microtome in which the pivoting device is mounted on the body of the microscope or observation device. Applicants respectfully request reconsideration and allowance of Claim 9.

Claim 11 depends from Claim 9 and thus incorporates all the limitations of that claim. Because, as discussed above, the Persson '844, Yasunaga, Persson '578 and Staehle patents fail to render obvious Claim 9, they also fails to render obvious Claim 11. Applicants respectfully request the removal of the rejections of Claim 11 and allowance of that claim.

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U.S. Patent Application No. 10/709,871
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Conclusion

Applicants respectfully submit that the present application is now in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned attorney of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully yours,



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